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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,461	06/05/2001	Dan Kikinis	004688.P026	6271
33448	7590	09/09/2004	EXAMINER	
ROBERT J. DEPKE LEWIS T. STEADMAN HOLLAND & KNIGHT LLC 131 SOUTH DEARBORN 30TH FLOOR CHICAGO, IL 60603				LERNER, MARTIN
ART UNIT		PAPER NUMBER		
		2654		
DATE MAILED: 09/09/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/875,461	KIKINIS ET AL.
	Examiner	Art Unit
	Martin Lerner	2654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 to 29 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 to 29 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/19/01 8/28/01</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input checked="" type="checkbox"/> Other: <u>IDS: 01/31/02</u> . |

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested:

Voice Interactive Apparatus and Method for Electronic Program Guide (EPG)

2. The disclosure is objected to because of the following informalities:

On page 6, [0017], the commonly assigned U.S. Patent Application Serial No. 09/488,361 should be updated as –now U.S. Patent No. 6,421,067 issued 16 July 2002—.

On page 7, [0022], “is” should be deleted in “STB 110 is receives”.

On page 11, [0040], “antennae 311a-n” should be –antennae 315a—.

Otherwise, “antennae 311a-n” are not illustrated in Figure 3.

On page 12, [0042], “make” should be deleted in “may make personalize”.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4 and 5 recite the limitation "the display". There is insufficient antecedent basis for this limitation in the claim. The corresponding claims in the method and computer readable medium refer to an intervening claim setting forth "a display". Applicants have omitted the intervening claim setting forth "a display" for the apparatus claims. Thus, claims 4 and 5 improperly depend upon claim 2.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 10, 13, 20, and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by *Kuhn et al.*

Regarding independent claims 1, 10, and 20, *Kuhn et al.* discloses an apparatus, method, and computer readable medium, comprising:

"a unit to transmit and receive information via wireless" – remote control 10 and television 12 communicate wirelessly with one another through a bi-directional data

communication link through suitable radio frequency or infrared link (column 2, lines 25 to 49: Figure 1);

“a voice activated control unit to interact with an electronic programming guide” – a speech understanding system allows the user to give the television set and other associated equipment search and record commands through remote control 10 to search through an electronic program guide (column 3, lines 8 to 25: Figure 1);

“an indicator to indicate an availability of an interactive function in a program corresponding to the EPG” – the system is capable of displaying on-screen prompts and program guide information on both the television monitor screen, as illustrated at 24, and on the display screen 16 of the remote control, so that the user may make menu item selections and electronic program guide selections using the remote control screen, without the need to display the same information on the television while watching a program (column 2, line 50 to column 3, line 8: Figure 1).

Regarding claims 13 and 23, *Kuhn et al.* discloses the system is capable of displaying on-screen prompts and program guide information on both the television monitor screen, as illustrated at 24, and on the display screen 16 of the remote control, so that the user may make menu item selections and electronic program guide selections using the remote control screen, without the need to display the same information on the television while watching a program (column 2, line 50 to column 3, line 8: Figure 1).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 3, 6, 7, 11, 12, 16, 17, 21, 22, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Kuhn et al.* in view of *Piotrowski*.

Concerning claims 2, 11, and 21, *Kuhn et al.* omits identifying a voice print of a speaker to gain operational access. However, it is very common for interactive voice response systems to provide a security feature to control access through a voice print when voice authentication is critical for valuable services. *Piotrowski* teaches a system and method for providing voice authentication by comparing spoken words from a user to pre-recorded voice reference data ("a voice print"). (Column 1, Lines 35 to 67) The objective is more effectively to verify the identification of credit card users at a lower cost, so that participating merchants and consumers can experience enhanced security. (Column 1, Lines 14 to 30) It would have been obvious to one having ordinary skill in the art to identify a voice print of a speaker as taught by *Piotrowski* in the remote control for accessing an electronic program guide of *Kuhn et al.* for the purpose of more effectively verifying the identification of a user at lower cost and enhanced security.

Concerning claims 3, 12, and 22, *Kuhn et al.* omits a memory to store verbal commands prior to transmitting the verbal commands. However, it is well known for

interactive voice response systems to buffer speech prior to transmission. *Piotrowski* teaches a system and method for providing voice authentication, which includes a random access memory (RAM) 16 for temporary storage of information. (Column 3, Lines 31 to 33: Figure 1) The user interface may be a personal computer (PC). (Column 5, Lines 22 to 25) Implicitly, random access memory for a user interface that is a personal computer would buffer speech prior to transmission.

Concerning claims 6, 7, 16, 17, 26, and 27, *Kuhn et al.* suggests that remote control 10 has a touch sensitive screen similar to a personal digital assistant (PDA) (column 2, lines 55 to 59), but does not expressly disclose that the remote control is a personal digital assistant or a web phone. However, a personal digital assistant and a web phone are art recognized alternatives for inputting voice data. *Piotrowski* teaches a system and method for providing voice authentication, where voice input may be provided via a telephone input system 2, a personal digital assistant, or other mobile voice communication device. (Column 5, Lines 11 to 25) Telephone 2 is connected to remote web servers 8, 90, and 96 via PSTN 5, so that telephone 2 is equivalent to a “web phone”. It would have been obvious to one having ordinary skill in the art to provide voice input through a personal digital assistant (PDA) or web phone as suggested by *Piotrowski* in the remote control for accessing an electronic program guide of *Kuhn et al.* because these are art recognized alternatives of inputting voice data for interactive voice response (IVR) interfaces.

9. Claims 8, 9, 14, 15, 18, 19, 24, 25, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Kuhn et al.* in view of *Dinwoodie*.

Kuhn et al. discloses remote control 10 includes a lighted display, but does not say that the unit generates a sound, illuminates, changes background colors of the display, or displays flashing to indicate availability of an interactive function. However, these various methods of operating a display are known in the prior art for drawing attention to a required user response. Specifically, *Dinwoodie* teaches an analogous art interactive remote auction bidding system, where a warning that a current bid is about to be accepted is communicated through audio feedback (such as a drumroll) ("a sound") or video feedback (such as a flashing bid amount ("displays flashing")("illuminates") or change in color ("changes background colors") of bid amount) in display 32. (Column 6, Lines 18 to 29) *Dinwoodie* says the remote auction system allows participants at remote locations to participate in an interactive manner via real-time. It would have been obvious to one having ordinary skill in the art to provide features of generating a sound, illuminating, changing background colors, and displaying flashing on a display of a remote control of *Kuhn et al.* for the purpose of permitting participants at remote locations to participate in a real-time manner and to draw attention to a required user response.

10. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Kuhn et al.* in view of *Piotrowski* as applied to claim 3 above, and further in view of *Dinwoodie*.

Claims 4 and 5 correspond to the limitations of claims 14, 15, 24, and 25, discussed above, and incorporate the feature of and are dependent on claim 3, discussed above. As noted, claims 4 and 5 improperly depend upon claim 3.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to Applicants' disclosure.

Contolini et al. and Maes et al. disclose related art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin Lerner whose telephone number is (703) 308-9064. The examiner can normally be reached on 8:30 AM to 6:00 PM Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil can be reached on (703) 305-9645. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ML
8/30/04


Martin Lerner

Examiner
Group Art Unit 2654